APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/694,191	10/23/00	WALKER J	96-059X

TM02/0912

WALKER DIGITAL CORPORATION
ONE HIGH RIDGE PARK
STANDFORD CT 06905-1326

EXAMINER
SOUGH, H

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 09/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev.11/00)

1- File Copy

Office Action Summary	Application No.	Applicant(s)
	09/694,191	Walker et al.
	Examiner	Art Unit
	Huyng S. Sough	2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _three_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-25_____ is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-25_____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a) ☐ All b) ☐ Some* c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _2_

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Specification

1.   The disclosure is objected to because of the following informalities:

• Page 18, line 4, should "908" be --907--? .

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3.   Claims 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Vizcaino

(US PAT. 5,317,636).

Vizcaino (FIG. 4) discloses an apparatus for facilitating a financial account transaction,

comprising: a processing unit (82); an input device (104) connected to said processing unit (82)

for inputting a financial account identifier thereto; a transmitting/receiving device (104)

connected to said processing unit for transmitting the financial account identifier for verification

thereof and for receiving information regarding authorization of the transaction; and an output device (104) connected to said processing unit for outputting the information regarding authorization of the transaction, wherein the financial account identifier is a single-use financial account identifier (verification number) containing information specific to the transaction. Vizcaino further discloses the claimed method (col. 7, line 23-col. 8, line 30).

4.   Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Pegg (US PAT. 5,163,097).

Pegg discloses a method for verifying a single-use financial account identifier, comprising the steps of: providing a memory device (110) containing data representing a plurality of predetermined single-use financial account identifiers (algorithm 118 will generate a plurality of predetermined single-use financial identifiers, col. 3, lines 7-13) and data representing a status for each of said plurality of predetermined single-use financial account identifiers (col. 6, lines 1-10); receiving said single-use financial account identifier; comparing (step 245) said single-use financial account identifier with said plurality of predetermined single-use financial account identifiers to identify one predetermined single-use financial account identifier matching said single-use financial account identifier; and verifying said single-use financial account identifier in accordance with said comparison and the data representing the status of said one predetermined single-use financial account identifier (col. 5, lines 3-8).

5.   Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Canfield (US PAT. 5,754,653).

Re claim 1: Canfield discloses a method for generating a single-use financial account

identifier (i.e., "a verification code, which changes for each use of a credit card or check"),

comprising the steps of:

accessing a first data element (i.e., "a multiple digit base code 1"), specific to an account

(col. 3, line 40-43);

accessing a second data element (i.e., "a variable number 3") including transaction-

specific data (col. 3, lines 59-61); and

combining said first data element and said second data element to produce said single-use

financial account identifier (col. 3, lines 59-64).

Re claim 2: Canfield further discloses that the step of accessing said first data element

includes accessing an account identifier (col. 3, lines 40-43, "assigns a multiple digit base code 1

to each checking or credit card account").

Re claim5: Canfield further discloses that the step of accessing said second data element

includes accessing a payment amount (col. 3, lines 59-61).

Claim Rejections - 35 U.S.C. § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-3, 7-11, 13, 14, 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Vizcaino in view of Canfield.

Vizcaino discloses a method for generating a single-use financial account identifier (col. 2, line

65-col. 3, line 6, i.e., "a verification number") by accessing a second data element (i.e., "a

transaction sequence number") including transaction-specific data (col. 3, lines 59-61).

     Re claims 1 and 2: Vizcaino does not explicitly disclose the steps of (a) accessing a first

data element, specific to an account (col. 3, line 40-43) and (b) combining said first data element

and said second data element to produce said single-use financial account identifier (col. 3, lines

59-64). However, Canfield discloses the steps of (a) accessing a first data element (i.e., "a

multiple digit base code 1"), specific to an account (col. 3, line 40-43) and (b) combining said

first data element and said second data element to produce said single-use financial account

identifier (col. 3, lines 59-64) to provide a security code system for checks and credit cards.

Further, Canfield discloses that the step of accessing said first data element includes accessing an

account identifier (col. 3, lines 40-43, "assigns a multiple digit base code 1 to each checking or

credit card account"). Thus, it would have been within the level of ordinary skill in the art to

modify the method of Vizcaino by adopting the teachings of Canfield to further enhance the

security code system for checks and credit cards.

Re claim 3: Neither Vizcaino nor Canfield explicitly discloses the account identifier

being alpha-numeric. However, the use of numeric or alpha-numeric for an account identifier is

old and well-known in the art and nothing unobvious is seen to have been involved simply

having employed one of these old and well-known practices for identifying an account of the

sort here involved.

Re claims 7 and 10: Neither Vizcaino nor Canfield explicitly discloses that (a) the step

of accessing said first data element includes encrypting said first data element or (b) the

combining step includes encrypting said first data element and said second data element.

However, Vizcaino discloses the step of accessing the data element including encrypting the

data element (col. 2, lines 39-41). Thus, encrypting any desirable data element or elements is a

matter of obvious design choice which a person of ordinary skill in the art would have found

obvious and applicant has provided no evidence that would indicate his particular steps (i.e.,

encrypting the first data element or encrypting said first data element and said second data

element) give rise to any new or unexpected result.

Re claims 8, 9, and 11: Neither Vizcaino nor Canfield explicitly discloses the use of a

private key encryption technique or a hashing function. However, Vizcaino discloses the use

of "Data Encryption Standard algorithm" (col. 6, lines 32-45). Further, a private key

encryption technique and a hashing function are old and well-known technique and method

used for encrypting data and nothing unobvious is seen to have been involved simply having

employed these old and well-known technique and method for providing a secure transaction method of the sort here involved.

Re claim 13: Neither Vizcaino nor Canfield explicitly discloses the step of updating said second data element to initialize for a future transaction. However, it is an elementary practice in the art to update transaction specific data (i.e., transaction amount and balance) for a future transaction.

Re claims 14, 16, 17 and 19: Vizcaino in view of Canfield discloses the method as stated supra and the device (see FIGS. 2B and 4 of Vizcaino). Neither Vizcaino nor Canfield explicitly discloses various ways of encrypting data as claimed. However, Vizcaino further disclose the use of "Encrypt key" for the single-use financial account identifier and Canfield discloses the modification of data to generate the single-use financial account identifier. Thus, the claimed ways of encrypting data to generate the single-use financial account identifier would have been obvious design choices which a person of ordinary skill in the art would have found obvious and applicant has provided no evidence that would indicate the claimed ways of encrypting data give rise to any new or unexpected result.

8.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canfield in view of Pegg.

Canfield discloses the claimed method as stated supra except for the explicit disclosure of using a static account identifier and combining the static account data identifier with the first and second

data element. However, Pegg discloses the use of a static account identifier for a method to

provide secure access to a limited access system (col. 4, lines 16-47). Thus, it would have been

obvious to one of ordinary skill in the art to modify the method of Canfield by adopting the

teaching of Pegg to enhance the security of a limited access system.

9.   Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vizcaino

in view of Canfield as applied to claim 1 above, and further in view of Colbert (US PAT.

5,485,510).

Neither Vizcaino nor Canfield explicitly discloses the second data element including accessing a

time or accessing a merchant identifier. However, Colbert teaches the use of a verification

number (i.e., an authorization code) containing one or more fields (col. 1, lines 56-67, e.g., a

field used for identifying the vendor and a field specifies a limit of the time for the transaction) to

simplify the process of billing for the credit company or to restrict the transaction time. Thus, it

would have been within the level of ordinary skill in the art to modify the method of Vizcaino

and Canfield by adopting the teachings of Colbert to simplify the process of billing for the credit

company or to restrict the transaction time.

10.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vizcaino in view

of Canfield as applied to claim 1 above, and further in view of Pegg.

Neither Vizcaino nor Canfield explicitly discloses the use of a static account identifier and

combining the static account data identifier with the first and second data element. However,

Pegg discloses the use of a static account identifier for a method to provide secure access to a

limited access system (col. 4, lines 16-47). Thus, it would have been obvious to one of ordinary

skill in the art to modify the method of Vizcaino and Canfield by adopting the teaching of Pegg

to enhance the security of a limited access system.

11.   Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vizcaino in

view of Pegg.

Re claims 20, 23, and 24: Vizcaino discloses the method and the apparatus including a

communication unit (104) except for the explicit disclosure of using a plurality of predetermined

single-use financial account identifiers. However, Pegg teaches the use of a plurality of

predetermined single-use financial account identifiers (algorithm 118 will generate a plurality of

predetermined single-use financial identifiers, col. 3, lines 7-13) for providing secure access to a

limited access system. Thus, it would have been obvious to one of ordinary skill in the art to

modify the method and apparatus of Vizcaino by adopting the teaching of Pegg to enhance the

security of the claimed method and apparatus.

Re claim 21: Vizcaino discloses an input device (104).

Re claim 22: Neither Vizcaino nor Pegg explicitly discloses that the processor is

configured to update the data presenting a pointer. However, it is an elementary practice in the

art to update transaction specific data (i.e., transaction amount and balance) for a future

transaction. Further, Vizcaino and Pegg imply that their devices update the data representing a

pointer and update the data representing a status (i.e., Both Vizcaino and Pegg are directed to

the single-use financial account identifier and without updating, their devices cannot deny the

access, when the same identifier is used again illegally).

Double Patenting

12.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
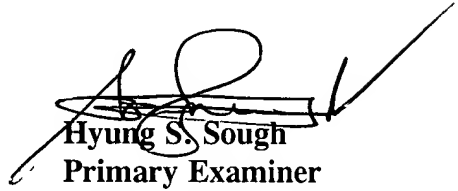
13.   Claims 1-14, 17, 20-22, and 24 are rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No.

6,163,771. Although the conflicting claims are not identical, they are not patentably distinct

from each other because the scopes of pending claims are fully covered by the claims 1-19 of

U.S. Patent No. 6,163,771.

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

        If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's
Supervisor, James P. Trammell, can be reached on (703) 305-9768.

        Any inquiry of a general nature or relating to the status of this application should be
directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax
number is (703) 308-1396.

                                                        Hyung S. Sough
                                                        Primary Examiner
                                                        Art Unit 2161

shs
September 9, 2001